

REMARKS

The present amendment is submitted in conjunction with a Request for Continued Examination (RCE) and in response to the final Office Action dated December 23, 2009, which set a three-month period for response, making an amendment due by March 23, 2010, and with the initial two-month period for response expiring on February 23, 2010.

Claims 1-31 are pending in this application, with claims 2, 7-9, 11-18, 22, 23, 26 and 27 having been withdrawn from further consideration pursuant to an election requirement.

In the final Office Action, the prior election restriction was made final and claims 2, 7-9, 11-18, 22, 23, 26 and 27 were withdrawn from further consideration. Claims 29 and 30 were objected to for an informality. Claims 1, 3-6, 10, 19-21, 24, and 25 were rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. Claims 1, 3-6, 10, 19-21, 24, and 25 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Claims 1 and 3 were rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 2,263,136 to Knouse et al. Claims 4-6 and 19-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Knouse et al in view of U.S. Patent No. 3,873,796 to Worobec, Jr. Claims 10, 24, and 25 were rejected under 35 U.S.C. 103(a) as being unpatentable over Knouse et al.

In the present amendment, claim 29 has been canceled, thus obviating the objection.

The claims were further amended to address the rejection under Section 112, second paragraph.

Regarding the rejection under Section 112, first paragraph, noted in paragraphs 5 and 6 of the final rejection, the Applicant is unclear whether this rejection is still pending or not. The Examiner notes on page 8 of the final rejection that "the rejection under 35 U.S.C. 112, 1st paragraph (paragraphs 5-6 of the Office Action) was inadvertently placed in the subject Office Action but clearly does not pertain to the present application and thus should be ignored".

However, the rejection is again set forth in the present Office Action on page 3.

Based on the Examiner's comments on page 8, the Applicant assumes, then, that the rejection "should be ignored".

In the event that the rejection is still pending, however, the Applicant notes that the features that the hand-held power tool comprises a housing and a barrel grip can be seen clearly in the figures and are also disclosed on page 6, lines 6-16 of the specification of the present application.

To more clearly define the present invention over the cited references, claims 1 and 28 were further amended to define that the hand-held power tool comprises an electrical switch, as shown in Fig. 5 of the present application. The features that the barrel grip and the detachable top handle comprise an on-off switch that is joined integrally with the electrical switch are disclosed in the specification on page 9, lines 7-11 of the present application. The attaching and detaching feature of the detachable top handle is disclosed on page 2, lines 12-

18 of the specification. The limitation of amended claim 1 that the barrel grip is formed as one piece with the housing is shown in Fig. 1 and is disclosed on page 6, lines 6-16 of the present application.

The new features of amended claim 28 were originally recited in claim 29 and are shown in Fig. 4. Claim 29 has therefore been canceled, as noted above. Claim 30 was amended to depend from claim 28, rather than claim 29.

In addition, new independent claim 31 has been added, which includes features of original claim 1 as well as features from page 2, lines 12-18, page 6, lines 6-16, and page 6, line 31 to page 7, line 8, of the specification.

The Applicant respectfully submits that the new and amended claims define subject matter that is neither disclosed nor suggested by the cited references, whether viewed alone or in combination.

The primary reference to Knouse discloses a portable power driven saw with a housing (a) and a handle (D) fastened to the housing (A) by means of screws (23). The handle (D) comprises opposed, symmetrical hollow members (14, 16) which are secured together as a unit by screws (18) for form two gripping portions that form a top hand grip (10) and a rear hand grip (12) of the portable power driven saw (Knouse, Fig. 1 and column 1, line 39 to column 2, line 20).

In addition, the handle (D) comprises two switch triggers (30, 32) which are interconnected and adapted upon actuation to operate a switch mechanism (34), secured within the handle (D) and connected through suitable leads to a source of power and a motor of the portable power driven saw (Knouse, column

3, lines 4-15). One of the two switch triggers (30, 32) is located in the top hand grip (10) of the handle (D) and the other is located in the rear hand grip (12).

However, Knouse does NOT disclose a barrel grip which is formed as one piece with the housing (A) and is provided for guiding the portable driven saw when the handle (D) is not attached to the housing (A) via the screws (23). Even if the rear end of the housing is interpreted as a "barrel grip", Knouse does not disclose a barrel grip which comprises an on-off switch that is integrally joined to an electrical switch and deactivates the portable power driven saw.

Furthermore, Knouse does not disclose a detachable top handle which can be attached and detached from the housing (A) to form an additional grip for an operator of the portable power driven saw. The handle (D) of Knouse is a main handle of the portable power driven saw which is only removed, for example for maintenance. The portable power driven saw of Knouse cannot be operated by an operator when the handle (D) is detached. The handle (D) includes all trigger switches (30, 32) to power the motor of the portable power driven saw.

In contrast, the hand-held power tool according to the present invention can be operated by an operator via the barrel grip which includes its own on-off switch to activate and deactivate the hand-held power tool.

In addition, Knouse does not disclose a further on-off switch that is at least partially integrated into the detachable top handle, wherein the further on-off switch is integrally joined to an electrical switch to activate and deactivate the portable power driven saw in an attached state of the detachable top handle.

The handle (D) of Knouse is a main handle of the portable power driven saw which is only moved, for example, for maintenance.

Claim 1 as amended therefore is not anticipated by Knouse. The Applicant furthermore respectfully submits that Knouse is not a proper reference under 35 USC 102 pursuant to the guidelines set forth in the last paragraph of MPEP section 2131, where it is stated that “a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently described, in a single prior art reference”, and that “the identical invention must be shown in as complete detail as is contained in the ... claim”.

Regarding claim 28, the cited reference to Worobec discloses a hand-held power tool that comprises a handle (20) and an on-off switch (80) which is at least partially integrated into the handle (20). Moreover, the hand-held power tool comprises a locking mechanism for locking the on-off switch (80). The locking mechanism includes at least two at least largely decoupled actuating elements (108, 126). The two actuating elements (108, 126) are situated on opposite sides of the handle (20), which are located in two parallel planes. The on-off switch (80) is also situated on one of the opposite sides of the handle (20). Thus, Worobec, Jr. does NOT disclose the on-off switch (20) that is located on a further side of the handle (20), which is located in a plane that is perpendicular to the planes of the opposite sides of the handle (20).

Claim 28 as amended therefore also is not anticipated by Worobec, Jr., since it includes features that are not disclosed by this reference.

Regarding claim 31, Knouse discloses a portable power driven saw with the features discussed above with regard to claim 1, so that the same arguments are relevant.

Knouse does NOT disclose an L-shaped housing, comprising a shorter leg and a longer leg. Further, Knouse does not disclose a barrel grip that is formed by the longer leg of the L-shaped housing. Additionally, Knouse does not disclose a detachable top handle which extends in an attached state from a free end of the long leg of the L-shaped housing to a free end of the shorter leg of the L-shaped housing.

Moreover, Knouse does not disclose a detachable top handle which is fixed in an attached state to a shorter leg of an L-shaped housing via a metal tab of an attaching device and which is fixed in an attached state to a longer leg of an L-shaped housing, via a detent mechanism of an attaching device.

New claim 1 therefore is also not anticipated by Knouse.

The Applicant further respectfully submits that the cited references also do not render obvious the subject matter of the pending and new claims.

Knouse teaches integration of two differently oriented gripping portion or hand grips (10, 12), respectively, in one handle (D) (Knouse, Fig. 1 and column 1, lines 52-55).

In contrast, the object of the present invention as defined in amended claim 1 and new claim 31 is to provide a hand-held power tool with a detachable top handle (12). Therefore, a user can choose a configuration of the hand-held power tool which fits his needs best; for example, he can remove the detachable

top handle (12) in case of a hindrance due to the attached top handle (12) during a work process and therefore has a hand-held power tool which can be operated with the barrel grip (10) and is compact and easy to use.

Because the Knouse reference does not disclose that the top hand grip (10) is formed separately to the rear hand grip (12), the practitioner is provided with no suggestion, teaching or motivation at the time the invention was made which would have led him to modify the handle (D) of Knouse to obtain a detachable top handle, as recited in amended claim 1 and new claim 31.

Furthermore, since Knouse chooses intentionally the integrally-formed hand grips (10, 12) in the handle (D) and especially points out that due to a handle with duplex grips, the advantages of two structures can be combined beneficially into one structure (Knouse, column 2, lines 35-40), Knouse actually teaches away from the present invention. The practitioner skilled in the art would not have been able to change the construction of the handle (D) or embody the top hand grip (10) and the rear hand grip (12) as separate parts, respectively.

Therefore, the subject matter of Knouse and the patent application actually contradict one another. The invention as defined in amended claim 1 and new claim 31 is therefore not rendered obvious by Knouse. When establishing obviousness under Section 103, it is not pertinent whether the prior art device possess the functional characteristics of the claimed invention, if the reference does not describe or suggest its structure. *In re Mills*, 16 USPQ 2d 1430, 1432-33 (Fed. Cir. 1990).

The application in its amended state is believed to be in condition for allowance. Action to this end is courteously solicited. However, should the Examiner have any further comments or suggestions, the undersigned would very much welcome a telephone call in order to discuss appropriate claim language that will place the application into condition for allowance.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Michael J. Striker', with a stylized flourish extending to the right.

Michael J. Striker
Attorney for Applicant(s)
Reg. No. 27233
103 East Neck Road
Huntington, New York 11743
631-549-4700